



8/17/04
PATENT
Att'y Dkt.: 11032/3002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MERRIMAN, Dwight et al.

Serial No.: 09/094,949

Filed: June 15, 1998

For: METHOD AND APPARATUS FOR
AUTOMATIC PLACEMENT OF
ADVERTISING

Examiner: J. Harle

Art Unit: 3627

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450

Alexandria, Va. 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Applicants submit this reply brief in the above-referenced application. The Examiner's Answer was mailed on October 24, 2003.

ISSUES

In the Examiner's Answer, the Examiner asserts that it is not whether the claims are obvious over any of the references but rather whether or not Kohda, et al. has the deficiencies claimed. If the deficiencies claimed are rectified by the additional prior art then Appellants' Brief is moot as they never argued the deficiencies of the 103 references or any motivations to combine." Examiners Answer, page 2.

This position taken in the Examiner's Answer is incorrect, and Appellants again assert that the issues are whether the claims are obvious over the applied references. After all, the Examiner rejected the claims under 35 U.S.C. 103. Furthermore, in the Appeal Brief, the deficiencies of Kohda in regards to the claims of the application are

discussed in detail. See Appeal Brief, pages 5-9. Moreover, Appellants point out in the Appeal Brief how none of the secondary references used to reject the claims disclose or suggest features recited in the claims, and that the secondary references do not provide motivation to modify the structure of Kohda. See Appeal Brief, pages 6-7 and 9. Thus, the Examiner's assertion that Appellants never argued the deficiencies of the 103 references or any motivations to combine is incorrect.

KOHDA DOES NOT RECEIVE FEEDBACK FROM AN ADVERTISER WEB SITE

In the Appeal Brief, Appellants asserted that Kohda does not disclose or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. See Appeal Brief, pages 5-6. Appellants further asserted that instead, Kohda discloses obtaining information for selecting advertisements from the user or from the users' augmented Web browser, and not from an advertisers' Web site. Id.

In response, the Examiner asserts that Kohda discloses that a click-through/link from a user's augmented Web browser is a "direct result" of the advertiser's Web site and thus is feedback from the advertiser's Web server. See Examiner's Answer, page 8. This statement seems to contradict the statement that "[T]he examiner has asserted and maintains all along that Kohda, et al. disclosed obtaining feedback from a user's browser." See Examiner's Answer, page 18.

Notwithstanding, the Examiner seems to feel that the secondary references somehow solve this deficiency of Kohda. The Examiner states that she has cited two different references with motivation to combine for selecting based upon feedback that was already obtained by Kohda, that Appellants did not dispute these teachings of the secondary references, treated Kohda as a 102 teaching and ignored all of the 103 reference teachings and motivations to combine. See Examiner's Answer, page 18. These assertions are incorrect, as further explained below.

Appellants asserted in the Appeal Brief that Cespedes and Harvey do not solve the deficiencies of Kohda because they also do not disclose or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user

transactions resulting from user response to at least one of a plurality of direct advertisements, as recited in independent claims 85 and 90. See Appeal Brief, page 6. If neither the primary Kohda reference shows this feature (the Examiner admits that Kohda discloses obtaining feedback from a user's browser, as discussed above) nor the secondary references show this feature, then the combination can not render obvious the claims of the application. The Examiner has not asserted that Cespedes or Harvey disclose receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. Instead, the Examiner relies on "selecting based on advertiser feedback" as allegedly taught by Cespedes and Harvey.¹

However, as asserted in the Appeal Brief, none of the secondary references provide any motivation to modify the structure of Kohda to include feedback from the advertiser Web site. Kohda specifically teaches receiving information from the user, through the filters on the augmented Web browser stored on the user's computer. The cited references provide no motivation to move the Kohda filters to an advertiser's Web site, or to otherwise modify Kohda to receive feedback from the advertiser's Web site. See Appeal Brief, pages 6-7.

The Examiner states that there is no apparent reason why the system and method could not be modified as set forth under the 103 rejections. See Examiner's Answer, page 19, lines 13-16. However, the Examiner has not suggested how the structure of Kohda could or would be modified to function as suggested, and has not provided motivation for any such modification. The Examiner has taken the general teaching of the Cespedes and Harvey references of using advertiser feedback and asserted that this could be combined with the system of Kohda to somehow result in the claimed invention. This position is incorrect because neither Kohda, Cespedes nor Harvey disclose receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. The general teaching of using advertiser feedback of Cespedes and Harvey does not cure this deficiency of Kohda.

¹ While the Examiner has acknowledged that Kohda is at least missing the element of selecting an advertisement based on advertiser feedback, it is Appellants position that Kohda is missing more than the selection feature. Since Appellants have argued that Kohda fails to disclose receiving feedback from the advertiser web site representing user transactions, it goes without saying that Appellants position also

KOHDA DOES NOT SELECT AN ADVERTISEMENT FOR DISPLAY FROM AMONG THE SAME PLURALITY OF ADVERTISEMENTS TO WHICH THE USER RESPONDED

In the Appeal Brief, Appellants asserted that Kohda does not disclose or suggest receiving feedback representing user transactions resulting from user response to at least one of a plurality of direct advertisements, and then selecting, based at least in part on the advertiser feedback, a direct advertisement from the same plurality of direct advertisements, as required by independent claims 85 and 90. In Kohda, any advertisements selected by the agent's Web server may be completely different from advertisements seen on the users augmented Web browser. The Examiner's Answer fails to even address this distinction.

MEANS CLAIM 100 IS NOT OBVIOUS

In the Appeal Brief, Appellants pointed out that the Examiner has failed to properly interpret claim 100 as required by 35 U.S.C. §112, paragraph 6, which requires that such a claim shall be construed to cover the corresponding structure described in the specification, and equivalents thereof. In the Examiner's Answer, the Examiner repeats means recitations from claim 100, each followed by structure from Kohda. It is respectfully submitted that the Examiner has again failed to properly address the means recitations of claim 100 as required by 35 U.S.C. §112, paragraph 6.

The Examiner has failed to identify the claimed function in each recitation, has failed to construe the claimed function, and has failed to identify structure disclosed in the specification for performing the function. Further, the Examiner has failed to determine whether the prior art discloses the identical function and the same or equivalent structure. As such, the Examiner has failed to establish a *prima facie* case of obviousness regarding claim 100.

As pointed out in the Appeal Brief, claim 100 of the present application recites, *inter alia*,

“means for receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements”

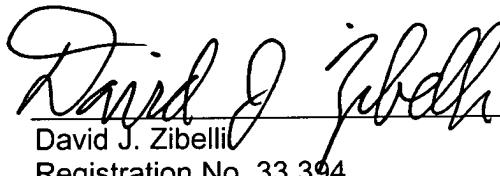
includes that Kohda fails to disclose advertiser selection based on the feedback. If Kohda doesn't receive the advertiser feedback, necessarily it cannot select an advertisement based on that missing feedback.

The function recited in this recitation is receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. The recited functionality requires that the feedback be received from an advertiser Web site. None of the cited references disclose this functionality, nor do they disclose the same or equivalent structure to that set forth in the present specification for carrying out that function, as explained in detail in the Appeal Brief. See Appeal Brief, pages 8-9. The mere recitation of means language from claim 100 followed by structure in Kohda does not satisfy the Examiner's burden to establish a *prima facie* case of obviousness, and as such the Examiner has failed to establish obviousness of claim 100.

CONCLUSION

Applicant respectfully requests reversal of the rejections of claims 85-100. These claims are allowable over the cited art.

Respectfully submitted,

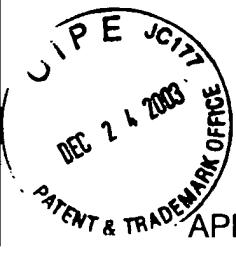


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Respectfully submitted,

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		Filing Date	6/15/1998
		First Named Inventor	MERRIMAN et al.
		Art Unit	3627
		Examiner Name	J. Harle
Total Number of Pages in This Submission		Attorney Docket Number	
		11032/3002	

ENCLOSURES (check all that apply)

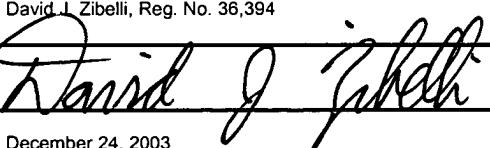
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Firm or Individual name	David J. Zibelli, Reg. No. 36,394
Signature	
Date	December 24, 2003

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